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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,631	04/17/2001	David A. Hughes	50P4092	7211
24337	7590	01/28/2008	EXAMINER	
MILLER PATENT SERVICES			SHERR, CRISTINA O	
2500 DOCKERY LANE			ART UNIT	PAPER NUMBER
RALEIGH, NC 27606			3621	
			MAIL DATE	DELIVERY MODE
			01/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/836,631	HUGHES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	CRISTINA OWEN SHERR	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 April 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \*    c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/14/2008</u> . | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

1. In view of the appeal brief filed on April 23, 2007, PROSECUTION IS HEREBY REOPENED. Claims 1-29 are currently pending in this case.
2. To avoid abandonment of the application, appellant must exercise one of the following two options:
  - (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
  - (2) request reinstatement of the appeal.
3. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Information Disclosure Statement***

4. The information disclosure statement (IDS) submitted on January 14, 2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-10 and 13-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan (US 6460,076).

8. Regarding claim 1 –

Srinivasan discloses a method of facilitating a transaction for downloadable digital data over an electronic network (e.g. abs), the method comprising: maintaining a presence to which a consumer connects on the electronic network (e.g. col 2 ln 5-10, where "location" ="presence"); transmitting a page from the presence to the consumer over the electronic network, the page including information concerning the downloadable digital data (e.g. col 2 ln 9-11);

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receiving a command from the consumer over the electronic network indicating that the consumer is engaging in a transaction for the downloadable digital data (e.g. col 2 ln 42-55); and

transmitting format options from the presence to the consumer over the electronic network via the page, the format options being selectable by the consumer and including at least one of

- (i) types of software on which the downloadable digital data is to be executable;
- (ii) types of portable devices on which the downloadable digital data is to be stored;
- (iii) types of compression formats in which the downloadable digital data is to be configured;
- (iv) types of CODECs through which the downloadable digital data is to be processed, and
- (v) types of digital rights management to which the downloadable digital data is to be subjected. (e.g. col 4 ln 65 – col 5 ln12, in which CD's and DVD's and their recorders are examples of types of portable devices).

9. Although Srinivasan does not specifically disclose each and every one of the options in claim 1, he does disclose at least one of the listed options. Further, it would be obvious to one of ordinary skill in the art to adapt the teachings of Srinivasan to obtain the instant application, motivated by "variations and modifications commensurate with the above teachings, and the skill or knowledge of the relevant art, within the scope of the present invention. The embodiments described hereinabove are

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further intended to explain best modes known for practicing the invention and to enable others skilled in the art to utilize the invention in such, or other, embodiments and with various modifications required by the particular applications or uses of the present invention." (Srinivasan at col 8 ln 1-9). Further, KSR forecloses the argument that as specific teaching is required for a finding of obviousness. *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396.

10. Regarding claims 2-5 –

Srinivasan does not specifically disclose all the alternative limitation of claim 2. Srinivasan, does, however, contemplate, a choice of portable devices (e.g. col 4 ln 65 – col 5 ln 12, in which CD's and DVD's and their recorders are examples of types of portable devices), downloading of encrypted content (e.g. col 7 ln 38-47), downloading of compressed content (e.g. col 7 ln 38-47), and verification of different types of digital managed digital rights (e.g. col 7 ln 29-34). Thus, it is obvious to one of ordinary skill in the art that compatibility among these several options must somehow be assured in order to carry out a transaction. It is further obvious, that the consumer must somehow choose the compatible options in order to for the transaction to be carried out when he/she is making such choices (e.g. col 5 ln 45-60 )

11. Regarding claim 7 –

Srinivasan discloses wherein the downloadable digital data includes at least one of audio data, video data, and text data. (e.g. col 2 ln 12-15).

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12. Regarding claim 8 –

Srinivasan discloses wherein each type of software, each type of compression format, each type of digital rights management, and each type of portable device is displayed on the page and selectable by way of activation by the consumer. (e.g. col 3 ln 47-60).

13. Regarding claim 9 –

Srinivasan discloses comprising receiving the consumer's selection of at least one of the type of software, the type of compression format, the type of digital fights management, and the type of portable device, over the electronic network at the presence. (e.g. col 5 ln 45-60 )

14. Regarding claim 10 –

Srinivasan discloses transmitting the downloadable digital data to the consumer over the electronic network in a format consistent with at least one of the selected type of software, the selected type of compression format, the selected type of digital rights management, and the selected type of portable device. (e.g. col 5 ln 55-60). Note that since the consumer has already entered his/her choices, and the method of Srinivasan has already made a point of not granting the request if the choices are not compatible with what is available, e.g., col 5 ln 53-56, there would be no point is transmitting incompatible digital items).

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15. Regarding claim 13 –

Srinivasan does not disclose the specific limitation of claim 13 regarding secure digital music initiative (SDMI) specifications. Nevertheless Srinivasan does contemplate the use of certain security measures such as encryption of data (e.g. col 5 ln 60 – col 6 ln 12) in order to prevent unauthorized copying . It would be obvious to one of ordinary skill in the art to replace one set of rules by another as long as rules themselves are involved.

16. Regarding claim 14 –

Srinivasan discloses wherein the electronic network comprises the Internet and the (SIC) comprises a web site thereon. (e.g. abs, wherein “world wide web” = “Internet”).

17. Claims 11-12, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan (US 6460,076) in view of Fritsch (US 6,233,682)

18. Srinivasan discloses a discussed above.

19. Fritsch discloses storing all the “particulars” of a sale so that customer may go back to the purchased item at will. It would be obvious to combine the teachings of Srinivasan and Fritsch since both are in the field of selling digital data such as music over the Internet and motivated by the economy of time and effort that would

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be obtained if consumers did not need to enter all their information every time they used the system.

20. Regarding claims 15-29 -

Claim 15 is rejected under the same criteria as claim 1, above.

21. Regarding claim 16 -

Claim 16 is rejected under the same criteria as claim 2, above.

22. Regarding claim 17 -

Claim 17 is rejected under the same criteria as claim 7, above.

23. Regarding claim 18 -

Claim 18 is rejected under the same criteria as claim 3, above.

24. Regarding claim 19 -

Claim 19 is rejected under the same criteria as claim 10, above.

25. Regarding claim 20 -

Claim 20 is rejected under the same criteria as claim 13, above.

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26. Regarding claim 21 –

Claim 21 is rejected under the same criteria as claim 14, above.

27. Regarding claim 22 –

Claim 22 is rejected under the same criteria as claim 1, above.

28. Regarding claim 23 –

Claim 23 is rejected under the same criteria as claim 2, above.

29. Regarding claim 24 –

Claim 24 is rejected under the same criteria as claim 7, above.

30. Regarding claim 25 –

Claim 25 is rejected under the same criteria as claim 3, above.

31. Regarding claim 26 –

Claim 26 is rejected under the same criteria as claim 10, above.

32. Regarding claim 27 –

Claim 27 is rejected under the same criteria as claim 13, above.

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33. Regarding claim 28 –

Claim 28 is rejected under the same criteria as claim 14, above.

34. Regarding claim 29 –

Claim 29 is rejected under the same criteria as claims 1-12, above.

35. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA OWEN SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

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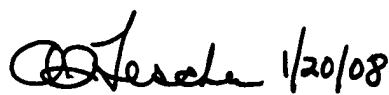
38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571)272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cristina Owen Sherr  
Patent Examiner, AU 3621

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



1/20/08

Andrew J. Fischer.

ANDREW J. FISCHER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600